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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,372	10/28/2003	Michael A. Urbancic	20031009-003	5316
7590 03/23/2006			EXAM	INER
Sud-Chemie			GRIFFIN, WA	LTER DEAN
Attention: IP/Legal Department 1600 West Hill Street			ART UNIT	PAPER NUMBER
Louisville, KY 40210			1764	
			DATE MAIL ED: 03/23/2000	ć

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)				
	10/695,372	URBANCIC ET AL.				
Office Action Summary	Examiner	Art Unit				
	Walter D. Griffin	1764				
 The MAILING DATE of this communication app Period for Reply 	ears on the cover sheet with the c	orrespondence address				
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tirr rill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).				
Status .						
1) Responsive to communication(s) filed on 28 Oc	ctober 2003.					
2a) ☐ This action is FINAL . 2b) ☑ This) This action is FINAL . 2b) ☑ This action is non-final.					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is						
closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	53 O.G. 213.				
Disposition of Claims						
4)⊠ Claim(s) <u>1-20</u> is/are pending in the application.						
4a) Of the above claim(s) is/are withdrawn from consideration.						
5) Claim(s) is/are allowed.						
6) Claim(s) <u>1-20</u> is/are rejected.						
7) Claim(s) is/are objected to. 8) Claim(s) are subject to restriction and/or	r election requirement					
o) Claim(s) are subject to restriction and/or	election requirement.					
Application Papers						
9) The specification is objected to by the Examine						
10) ☐ The drawing(s) filed on is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.						
Applicant may not request that any objection to the	• • • • • • • • • • • • • • • • • • • •					
Replacement drawing sheet(s) including the correcting 11) The oath or declaration is objected to by the Ex						
Priority under 35 U.S.C. § 119						
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of:						
1. ☐ Certified copies of the priority documents have been received.						
<u> </u>						
3. Copies of the certified copies of the prior	ity documents have been receive	ed in this National Stage				
application from the International Bureau	ı (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.						
Attachment/c)						
Attachment(s) 1) Notice of References Cited (PTO-892)	4) Interview Summary	(PTO-413)				
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ate				
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal P 6) Other:	Patent Application (PTO-152)				

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 contains the trademark/trade name Catofin®. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a catalyst and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 1764

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over admitted prior art in view of Houdry (US 2,419,997) and Herbstman (US 4,409,417).

Through the use of the Jepson claim format, applicants admit that steps (a)-(f) are prior art.

The cycle extension and hydrogen introduction are not admitted as being prior art.

The Houdry reference discloses that time of contact can be changed during operation in order to balance heat. Time is necessarily measured in units such as seconds and minutes. See column 2, line 58 through column 3, line 51.

The Herbstman reference discloses the presence of hydrogen during dehydrogenation. See column 3, line 55 through column 4, line 23. Art Unit: 1764

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It would have been obvious to one having ordinary skill in the art to change contact time during the reaction as suggested by Houdry because changing this time changes the heat balance. Changing the time so that it is longer would necessarily result in a delay in the process that would affect all aspects of the process.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the process of the prior art by including hydrogen in the amounts claimed in the process as suggested by Herbstman because formation of carbonaceous deposits will be reduced.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The EP reference discloses a dehydrogenation process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter D. Griffin whose telephone number is (571) 272-1447. The examiner can normally be reached on M-F 6:30 to 4:00 with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1764

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter D. Griffin Primary Examiner

Art Unit 1764

WG

March 17, 2006